

Remarks

This Application has been carefully reviewed in light of the Office Action mailed October 31, 2007. Applicant appreciates the Examiner's consideration of the Application. Applicant believes all claims are allowable without amendment and respectfully provides the following remarks. Although Applicant believes Claims 19-25 are allowable, in order to advance and expedite the issuance of a patent, Applicant will cancel Claims 19-25 without prejudice to be filed in a continuation application at a later date. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Examiner Interview

Applicant thanks the Examiner for the interview conducted on January 31, 2008. Applicant discussed the differences between the claimed linear regression techniques and the plurality of statistic types and the prior art. The Examiner made an oral election/restriction requirement with regard to Group 1, Claims 1-18, and Group 2, Claims 19-25. Applicant agreed to pursue Claims 1-18 and cancel without prejudice Claims 19-25.

II. Section 101 Rejection

The Examiner rejects Claims 19-25 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 20-25 are rejected because they depend from Claim 19.

Per the Examiner Interview, Applicant has cancelled Claims 19-25 without prejudice.

III. The Proposed Ciampi-Trade10.com-Li Combination is Improper

A. The proposed combination does not disclose all the claim limitations

The Examiner rejects Claims 1, 3-7, 9, 11, 14-16, 18, 19, 21-23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,167,837 issued to Ciampi ("*Ciampi*") in view of Trade10.com website (Multiple Linear Regression) ("*Trade10.com*") and further in view of U.S. Patent No. 6,453,303 issued to Li ("*Li*"). Applicant traverses this rejection.

The Examiner states that *Ciampi* does not show that at least some of the plurality of statistic types comprising financial information, other than the particular stock's past market price, specific to the entity associated with the particular stock. (Office Action at 4.)

The Examiner cites *Li* for the limitation of “based upon the estimates made using the equation, purchasing or selling at least some stocks, future contracts on at least some stocks, or options on at least some stocks, in the plurality of stocks.” The portion that the Examiner cites states, “editorials and comments may include advice as to risky investments, both short and long term, and recommendations for the best times to buy or sell assets.”

The plain language indicates that it is the **editorials and comments** that contain recommendations to buy or sell assets. The language does not suggest purchasing or selling at least some stocks **based on the estimates using the equation** as independent Claim 1 requires. (Emphasis added.)

Further, the combination does not disclose or suggest the requirement of “creating an equation for a plurality of stocks.” (Emphasis added.) The portion of *Ciampi* relied upon by the Examiner discloses that regression may be used to “determine the fair value of the asset.” Likewise in *Li*, the disclosure states, that regression may be used to “analyze the asset’s market value and determine if the asset is overbought or oversold.” Each of these techniques use regression to analyze a single asset.

Applicant’s invention by contrast, uses regression to create an equation for a plurality of stocks in a group to determine which assets are under- or over-valued in comparison with other assets in that group. The equation encompasses multiple stocks rather than a single stock. By comparison, the cited portions of the references disclose examining the market value of a single asset and making predictions of whether the single asset will increase or decrease in value without comparing it to others in the market class.

The invention also creates the equation using financial information specific to an entity associated with a particular stock. Thus, the invention provides a measurement of over- or under-pricing relative to other stocks in the group.

For at least the above reasons, the cited portions of the references the Examiner cites does not disclose each and every limitation in independent Claim 1. For analogous reasons independent Claim 11 is also allowable. Accordingly Applicant requests reconsideration and allowance of all pending claims.

B. The there is no apparent reason to make the proposed combination

It appears that the Examiner has merely argued that one of ordinary skill in the art at the time the invention was made *could have* modified *Trade10.com* and *Li* to perform the

acknowledged deficient limitations of *Ciampi* (a point which Applicant does not concede). However, it does not appear to Applicant that the Examiner has pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to actually incorporate “a plurality of statistic types that is correlated with actual market prices of the plurality of stocks wherein at lease some of the plurality of statistic types comprise financial information, other than the particular stock’s past market price, specific to the entity associated with the particular stock” as recited in Claim 1, into the particular techniques disclosed in *Ciampi* (*without using Applicant’s claims as a guide for doing so*). See M.P.E.P. § 2143.01(III) (stating that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination); see also *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Most recently, this requirement has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR v. Teleflex*, which recite, “it will be necessary ... to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue.”¹ Applicant submits that the statements made by the Examiner does not provide a supported explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention (*without using Applicant’s claims as a guide*) to modify *Ciampi* in the manner proposed by the Examiner; and (2) how one of ordinary skill in the art at the time of Applicant’s invention would have actually done so.

The Examiner merely states that it would have been obvious to one of ordinary skill in the art to have combined the three references. Applicant respectfully submits that the *Office Action* has simply not presented any “articulated reasoning with some rational underpinning” that it would have been obvious to make the proposed combination.

In fact the cited portion of *Ciampi* discloses that a related asset may include, “a stock, a bond, a market index, sector index, geographic index, a futures contract, a depositary receipt, a currency rate and/or other financial data.” The examples suggest financial information that is not “specific to the entity associated with the particular stock” as Independent Claim 1 requires. The cited portion of *Ciampi*’s disclosure may well teach away from using financial information that is “specific to the entity associated with the particular

¹ *KSR Int’l. Co v. Teleflex Inc.*, 550 U.S. ___, 82 U.S.P.Q.2d 1384 (2007) (emphasis added).

stock” as the examples in *Ciampi* are not specific to the entity associated with the particular stock.

Further, the cited portions of *Li* disclose software for generating and computing without user intervention forecasts of a financial asset’s performance and confidence bands as well as generating market commentary, which includes editorials/comments in addition to, or instead of, gathering the above information for display on the web page. Applicant would submit that there is no indication that one of ordinary skill would have thought to combine the teachings of *Ciampi* with *Li* and *Trade10.com* to arrive at the claimed invention.

For at least these reasons, Applicant requests that the Examiner withdraw the rejections and allow all pending claims or at least fully set out reasons: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention (*without using Applicant’s claims as a guide*) to modify *Ciampi* in the manner proposed by the Examiner; and (2) how one of ordinary skill in the art at the time of Applicant’s invention would have actually done so.

C. Request for Refund

At the interview, the Examiner gave notice of a Restriction Requirement of Group 1, Claims 1-18, and Group 2, Claims 19-25. Because the Restriction resulted in Applicant taking a one month extension, Applicant requests a refund in that amount to deposit account 02-0384. Applicant further requests the Examiner to confirm the restriction in writing.

IV. No Waiver

All of Applicant’s arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner’s rejections.

Conclusion

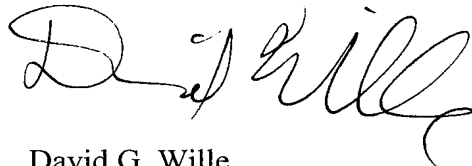
Applicant has made an earnest attempt to place the Application in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any way, the Examiner is invited to contact the undersigned attorney for Applicant at the Examiner's convenience at (214) 953-6813.

Applicant believes the fee for a one-month extension is due, the Commissioner is hereby authorized to charge the fee of \$60 to Deposit Account No. 02-0384 of Baker Botts L.L.P. Applicant is a small entity as defined by MPEP 509.02(a)(1). In light of the Examiner's oral request during the Examiner Interview for an election/restriction requirement, Applicant requests that the fee for the 1 month extension be waived and any charges made relating to the 1 month extension be credited to the above deposit account.

Respectfully submitted,

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